

### **REMARKS**

The Examiner rejected claims 19-36 and 91-110. By this amendment, claims 19-36 and 91-110 have been cancelled and claims 111-121 have been introduced. Therefore claims 111-121 are pending in the application.

#### *Claim Rejections – 35 USC § 112*

Claims 19-36 and 91-110 were rejected under 35 USC §112 as being indefinite because they are directed toward a method of use but contain predominately device structural limitations.

By the present amendment, Applicant has replaced the method of use claims with apparatus claims having substantially similar device structural limitations as the cancelled method of use claims.

Accordingly, it is respectfully submitted that the amendments overcome Examiner's claim §112 rejections such that reconsideration of the application is courteously solicited.

#### *Claim Rejections – 35 USC § 103*

Claims 19-36 and 91-110 were rejected under 35 USC 103(a) as being unpatentable over Dillon, JR et al (Dillon) US Pat. No. 5,031,983 in view of Bischel et al (Bischel) US Pat. No. 6,078,704.

Applicant respectfully disagrees with Examiner's assertion for the following reasons.

Examiner asserts in points (1), (2) and (4) in response to Applicant's arguments that a person skilled in the art would understand that the device of Dillon is not limited to applications requiring invariance since the device was made invariant for specific application wherein invariance was required. Examiner further asserts that since variability is taught by Bischel, the invention is obvious when Dillon is combined with Bischel. However, Examiner provides no

evidence to support either of these assertions, other than merely stating that motivation to combine Dillon with Bischel exists.

Applicant notes that Dillon is directed to an apparatus comprising a waveguide magneto-optic isolator for use in communications, whereas Bischel is directed to a method of using electrically controlled waveguide routing for use in displays. Accordingly, due to the disparate technologies that each document is directed towards, Applicant submits that the Examiner's rejection is unfounded and should be withdrawn. However, if Examiner continues to maintain the rejection, Applicant requests that the Examiner provide evidence to support the assertion that a person skilled in the art would obviously combine Dillon with Bischel. Furthermore, Applicant requests that the Examiner provide evidence to support the assertion that "one of ordinary skill in the art would know that such a method is not at all limited to applications requiring invariance". Examiner is reminded that "rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness" (see *KSR*, 550 U.S. at \_\_\_, 82 USPQ2d at 1396).

The Examiner asserts in points (3), (6) and (7) in response to Applicant's arguments that the device of Dillon would be functional as a variable attenuator as modified by the teachings of Bischel. Examiner further refers to Kumayasu et al (Kumayasu) US Pat. No. 6,792,192 and Iwaki et al (Iwaki) US Pat. No. 5,132,811 to support assertion that the combination of Bischel to Dillon would be obvious to a person skilled in the art.

Applicant notes that Bischel teaches an electro-optical system that manipulates indices of refraction of a waveguide to transversely extract a signal propagating along a propagation axis of the waveguide through the bounding/cladding regions of the waveguide. Applicant further notes that Dillon teaches a magneto-optic isolator that invariably rotates a polarization angle of an input radiation signal by about 45 degrees at an exit aperture constant polarization angle shift parallel to the propagation axis using an electro-magnetic field. Accordingly, the extraction method as taught by Bischel is inapplicable for use in modifying the apparatus as taught by

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Dillon so as to be functional as a variable attenuator such that the Examiner's rejection is unfounded and should be withdrawn.

Applicant further notes that Kumayasu or Iwaki does not provide any reference in their disclosure to Dillon or Bischel. Accordingly, since there is no motivation within the disclosure of Kumayasu or Iwaki that would lead a person skilled in the art to combine Dillon with Bischel, Applicant submits that Examiner's assertion that Kumayasu or Iwaki supports the combination of Bischel to Dillon is unfounded and should be withdrawn.

In view of the above remarks, Applicant believes the pending application is in condition for allowance. Applicant believes that no fees are due, however, if any become required, the Commissioner is hereby authorized to charge any additional fees or credit any overpayments to Deposit Account 08-2789.

Respectfully submitted

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